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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,201	06/02/2006	Karl-Josef Dierks	740145-318	3369

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ROBERT'S MLOTKOWSKI SAFRAN & COLE, P.C.
Intellectual Property Department
P.O. Box 10064
MCLEAN, VA 22102-8064

EXAMINER

LONEY, DONALD J

ART UNIT	PAPER NUMBER
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1794

NOTIFICATION DATE	DELIVERY MODE
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10/02/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/596,201

Applicant(s)

DIERKS, KARL-JOSEF

Examiner

Donald Loney

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 18-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 18, line 8 the phrase "essentially comprises" is recited. The use of a more closed end term (i.e. essentially) with an open ended term (i.e. comprises) appears in direct contrast to one another and it is unclear as to what is meant thereby. The applicant may of meant to use the more commonly recited restrictive phrase of "consisting essentially of"? Clarification and/or correction is kindly requested.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 18, 19, 21, 22, 23, 25, 30 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Glover et al (5007217).

Glover et al discloses a glazing unit comprising two glass panes 41, a fastener 47 for fixing the glass panes, a sealing element comprising a middle portion 71, two lateral gaps seals 43 and an elastic cushion 40 situated between the gap seals and

adjoining the middle part 71 per claims 18 and 19. Refer to figure 7. With regards to claim 21, see column 6, lines 61-66. With regards to claims 22 and 23, see column 7, lines 35-41. With regards to claim 25, With regards to claim 25, this process limitation, in a product claim, does not distinguish from the prior art. With regards to claims 30 and 31, see column 9, lines 51-56.

5. Claims 18, 19, 25, 26, 27, 30, 31, 32, 34 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Patil (3775914).

Patil discloses a glazing unit comprising two glass panes 12, 14, a fastener 24 for fixing the glass panes, a sealing element comprising a middle portion 18, two lateral gaps seals 38 and an elastic cushion 20 situated between the gap seals and adjoining the middle part 71 per claims 18 and 19. Refer to figures 1 and 3. With regards to claim 25, this process limitation, in a product claim, does not distinguish from the prior art. With regards to claims 26 and 27, see column 4, lines 41-48. With regards to claims 30 and 31, see column 5, lines 26-34. With regards to claims 32-35, see element 24 and column 4, lines 17-22.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 20, 24, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glover et al.

The primary reference teaches the invention substantially as recited except for the specific hardness of the material in claim 20 and the various limitations recited in the other dependent claims listed above. They are silent as thereto. See the 35 U.S.C. 102 rejection above.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Glover et al to form the cushion of whatever hardness is needed for a particular application since Glover teaches the cushion formed of an elastomeric silicone material as indicted above. With regards to claim 24, it would be obvious to form the gas tight layer on the inside surface of the cushion for the same reason Glover et al discloses the layer on the outside of the cushion (i.e. to provide a gas barrier thereto). With regards to claims 28 and 29, it would be obvious to provide a trough for placement of the gap seals in order to better anchor the materials together.

9. Claims 20, 21, 28, 29 and 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patil.

The primary reference teaches the invention substantially as recited except for the specific hardness of the material in claim 20 and the various limitations recited in the other dependent claims listed above. See the 35 U.S.C. 102 rejection above.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Patil to form the cushion of whatever hardness is needed for a particular application since Patil teaches the cushion formed of an elastomeric material as indicted above. With regards to claim 21, it would be obvious to form use any of the materials recited therein as the elastomeric material since Patil teaches the material as being elastomeric in general and is only silent as to the specific material therefore. With regards to claims 28 and 29, it would be obvious to provide a trough for placement of the gap seals in order to better anchor the materials together. With regards to claims 36 and 37, to include a bulge on the frame legs would be obvious to include for its biasing means against the glass sheets. With regards to claims 38 and 39, it would be obvious to form the frame of multiple sections since this would merely involve making the parts separable.

Response to Arguments

10. Applicant's arguments with respect to claims 18-34 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-1493. The examiner can normally be reached on Mon, Tues, Thurs and Fri. 8AM-4PM, flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Donald J. Loney/
Primary Examiner
Art Unit 1794

DJL;D.Loney
09/28/09